

## REMARKS

Applicant has made certain amendments to the specification to correct an acronym. Specifically, the acronym for “polymethylmethacrylate” is PMMA not PPMA. Thus, Applicant has amended the specification at page 7, line 15, page 8, line 7, page 13, line 5, and page 14, line 4 to correct this. Applicant has also made a corresponding correction to FIG. 4.

Claims 1-3 and 7-12 have been previously canceled, and claims 4-6 and 13-18 remain pending. Claims 4-5 and 13-17 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Obayashi et al (US 4,749,625) in view of Frederickson et al (US 6,476,317), and further in view of Nagata et al (US 6,582,785). Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Obayashi et al (US 4,749,625)/Frederickson et al (US 6,476,317)/Nagata et al (US 6,582,785) as applied to claims 4-5 and 13-17 above, and further in view of Gabower et al (US 6,624,432).

Applicant has amended claims 4 and 13 to more clearly identify a novel and non-obvious aspect of the invention.

### Claim 4

As amended, claim 4 now recites: “wherein said compound layer of PMMA-Poly covered metal-PMMA prevents both triboelectric charges and induction charges accumulated on said component”. The Examiner asserts that Obayashi discloses in Figs. 3-4 of the steps, aluminum and PMMA for shells and substantially all the claimed limitations. The examiner asserts that the combination of the references completes creation of the electrostatics discharge-free (ESD-free) container. Applicant disagrees with the above assertions and respectfully submits that none of

the cited references is directed to ESD protection and there is no motivation and reasonable expectation of success to combine the cited references for achieving the ESD-free as combined.

Obayashi discloses an amorphous metal laminate having an excellent electromagnetic wave-shielding property and, optionally, a water-proof property and stain-proof property. However, the Obayashi invention fails to teach that said compound layer of PMMA-Poly covered metal-PMMA that is used for the creation of the ESD-free component container prevents both triboelectric charges and induction charges accumulated on said component.

The box disclosed by Frederickson is also for radiation shielding, and more specifically for high energy radiation shielding, such as fast electrons, gamma rays or X-rays (col. 5, line 24-25). Frederickson does not teach or suggest an electrostatic discharge free component container for storing and transporting components which comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component.

Although Nagata appears to disclose a shield case for electronic equipment and providing a means for accessing the cavities, the means for accessing the cavities is fixed.

Applicant respectfully submits that neither the Obayashi nor the Frederickson nor the Nagata reference, singly or combined, teach or suggest the claimed “electrostatic discharge (ESD) free component container for storing and transporting components which comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component”. For at least this reason, the rejection of claim 4 should be withdrawn.

Further, the references are from a different technical field than that of the present invention. That is, they are “nonanalogous art”. The cited references are related to solving

electromagnetic radiation shielding problems. In contrast, the invention of claim 4 provides an electrostatic discharge free component container for storing and transporting components which comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicants endeavor or, if not, then be reasonably pertinent to the particular field.

Applicant further submits that the cited references themselves provide no motivation to combine. The examiner is reminded that to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142. The applicant submits that the Examiner has failed to satisfy these criteria in asserting that the rejected Claims are obvious in view of the Obayashi et al. combined with the Frederickson et al or the Nagata et al inventions.

The Examiner is further reminded that "in order to rely on a reference as a basis for rejection of an Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Examiner is still further reminded that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner is also reminded that "the teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Applicant submits that motivation to combine the Obayashi et al. with the Frederickson et al or the Nagata et al inventions is provided by the Applicant's disclosure, and not by the prior art.

It is therefore submitted that, as amended, independent claim 4 patentably defines over the cited art. Since claims 5-8 directly or indirectly depend from amended claim 4, claims 5-8 are patentable by virtue of their dependency from patentable amended claim 4.

#### Claim 13

As amended, independent claim 13 now recites: "wherein said surfaces prevent both triboelectric charges and induction charges accumulated on said component". The Examiner asserts that Obayashi et al discloses in Figs. 3-4 of the steps, aluminum and PMMA for shells and substantially all the claimed limitations. Obayashi indeed discloses an amorphous metal laminate having an excellent electromagnetic wave-shielding property and, optionally, a water-proof property and stain-proof property. The Obayashi invention fails to teach that said compound layer of PMMA-Poly covered metal-PMMA that is used for the creation of the ESD-free component container prevents both triboelectric charges and induction charges accumulated on said component.

Examiner asserts that the invention was made to modify Obayashi by creating a box, as taught by Frederickson, for the purpose of a means carrying electronic devices to protect from EMI. Applicant respectfully submits that neither Obayashi nor Frederickson teach or suggest an electrostatic discharge free component container for storing and transporting components which

comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component.

Although Nagata appears to disclose a shield case for electronic equipment and providing a means for accessing the cavities, the means for accessing the cavities is fixed. Thus, the Nagata invention does not teach or suggest “providing relatively quick entry and exit of at least one component that is used for manufacturing of semiconductor devices,” as claimed in amended claim 13.

Applicant respectfully submits that neither the Obayashi nor the Frederickson nor the Nagata reference, singly or combined, teach or suggest the claimed “electrostatic discharge (ESD) free component container for storing and transporting components which comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component”.

Further, the references are from a different technical field than that of the present invention. That is, they are “nonanalogous art”. The cited references are related to solving electromagnetic radiation shielding problems. In contrast, the invention of claim 13 provides an electrostatic discharge free component container for storing and transporting components which comprises a compound layer of PMMA-Poly covered metal-PMMA for prevention of both triboelectric charges and induction charges accumulated on the component. In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicants endeavor or, if not, then be reasonably pertinent to the particular field.

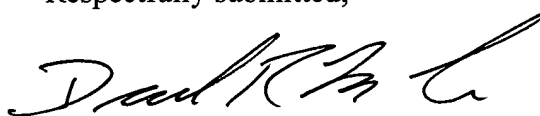
It is therefore submitted that amended claim 13 is patentable. Since claims 14-18 directly or indirectly depend from amended claim 13, claims 14-18 are patentable by virtue of their dependency from patentable amended claim 13.

For at least the foregoing reasons, Applicant submits that this application is now in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

### **CONCLUSION**

Applicants respectfully request submit that the foregoing is fully responsive to the election request and that all presently-pending claims (30-44) be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Daniel R. McClure', is written over a horizontal line.

Daniel R. McClure  
Reg. No. 38,962

**THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.**  
100 Galleria Pkwy, NW  
Suite 1750  
Atlanta, GA 30339  
(770) 933-9500